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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,866	03/02/2000	EGON SCHULZ	P00.0408	6105

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT PAPER NUMBER

2665

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/486,866

Applicant(s)

SCHULZ ET AL.

Examiner

Steven HD Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Pre-amendment***

1. Page 5, lines 11 to page 7, lines 5 of the pre-amendment are not enter because a partial of specification such pages 18-25 is not in the case. the specification only has pages 1-17 and 17a. However, a replaced by art 34 amendment has pages 13-25. Please clarify.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 1 recites the limitation "said first mobile station" in lines 13 does not refer to any previous element. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagting (WO 97/15160) in view of Ward (USP 5974320).

Regarding claims 1, 4 and 6-8, Hagting discloses (Figs 1-7 and Pages 1-20) the DECT systems (Fig 4) comprising a plurality of base stations (Fig 4, Ref 11 and 12) wherein at least one second base station is asynchronous to the first base stations which are synchronous with the mobiles parts; the at least one second base stations being in a proximity of the first base stations; first and second base stations and first base stations being connective by the wireless transmission messages (Fig 4, Ref 14-16 and Page 13, lines 23-27, the first base stations of first system are not synchronous with the second base stations of the second system so they are partially asynchronous with each other; during the handover the mobile receives the messages from both systems, See Fig 4b and Page 5, lines 13 to page 7, lines 25). However, Hagting fails to disclose the first base stations transmit the first messages which indicate the first base stations are surrounded by at least one of the second base stations. In the same field of endeavor, Ward discloses the first base stations regularly or automatically transmit the first messages having first information indicating that the first base stations are surrounded by at least one of the second base stations network side (Col 3, lines 5-24 and col. 8, lines 28-50).

Since, Hagting suggests that a list of the synchronous and asynchronous base stations can be provided. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of broadcasting a message which indicates the first base stations being surrounded by at least one of the second base stations as disclosed by Ward's system and method into Hagting's method and system. The motivation would have been to improve the battery life of the mobile unit.

Regarding claims 2-3, Hagting discloses a synchronism between the first base stations and the first mobile parts exists in idle or active locked mode the first mobile parts (Page 4, lines 8-14; Page 6, lines 20-25 and Page 15, lines 5-12)

Regarding claim 5, Hagting implicitly discloses the first base stations are respectively asynchronous relative to the second base station in view of at least one of bit, time slot and time frame synchronism.

Regarding claim 10, Hagting implicitly discloses the first mobile parts are respectively asynchronous relative to the first base station in view of at least one of bit, time slot and time frame synchronism.

#### ***Allowable Subject Matter***

7. Claims 9 and 11-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hjern (USP 5873033) discloses a method for transferring between the cordless system and cellular system.

Byrne (USP 5659598) discloses a method for transferring between the cordless system and GSM system.

Robert (USP 5878343) discloses a telecommunication system arrangement.

Abreu (USP 5754956) discloses a method and apparatus for portable radiotelephones scan the base stations

Abreu (USP 5754956) discloses a method and apparatus for synchronizing over the air.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Steven HD Nguyen  
Primary Examiner  
Art Unit 2665  
February 22, 2003